

**REMARKS****Summary of the Office Action**

Claims 1-3, 5 and 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 10-106012 (hereinafter "JP 012") or JP 2001-307370 (hereinafter "JP 370") either further considered with Lee et al. (U.S. Patent No. 6,345,029) (hereinafter "Lee") and further considered with Suzki et al. (U.S. Patent No. 4,262,208) (hereinafter "Suzki")<sup>1</sup>.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Ueyama (U.S. Patent No. 5,881,035) (hereinafter "Ueyama").

**Summary of the Response to the Office Action**

Applicant has amended claims 1 and 7 and added new dependent claim 9 to differently describe embodiments of the disclosure of the instant application. Accordingly, claims 1-3 and 5-9 are currently pending for consideration.

**Rejections under 35 U.S.C. 103(a)**

Claims 1-3, 5 and 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 012 or JP 370) either further considered with Lee and further considered with Suzki. Claim 6

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<sup>1</sup> It is respectfully submitted that the Office Action is not clear as to exactly what documents are being applied in the rejections under 35 U.S.C. § 103. For example, in section 1 of the Office Action at page 2, the Examiner refers to "Lee et al." and "Suzuki et al." without specifically indicating the document numbers for these references to any extent. Accordingly, Applicant understands that the actual art cited is as specified in the "Summary of the Office Action" section of this Amendment document. However, to the extent that Applicant's understanding is incorrect in any of these regards, the Examiner is requested to provide clarification in the next Office Communication.

stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Ueyama. Applicant has amended claims 1 and 7 and added new dependent claim 9 to differently describe embodiments of the disclosure of the instant application. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Independent claim 1 of the instant application has been newly-amended to describe an advantageous combination of features of an optical pickup device in which the through-portion (17A) of the light-shielding panel (17), the focusing position of the objective lens (22), and the light detector (28) are in a conjugate relationship with respect to an emission point of the light beam (LB) of the light source (11). See, for example, Fig. 1 of the instant application.

The Examiner asserts, at page 3 of the Office Action, that “the placement of an appropriate ‘light-shielding’ element at the conjugate plane/position” is well known in the optical arts. The Examiner refers to Fig. 1 of Suzki in this regard. With reference to Fig. 1 of Suzki, the light shield 11 and the aperture 4 are positioned at the conjugate points of the light source 7. Applicant notes in this regard, however, that while it is not clear from Fig. 1, the aperture 4 is positioned at the conjugate point because a description is provided at col. 3, lines 12-14 of Suzki that “[t]he light source 7 is focused ... on the aperture 4.”

However, Applicant respectfully submits that, contrary to the arrangement described in the combination of features of independent claim 1 of the instant application, the mask 1 or wafer 2 in Suzki is not positioned at the conjugate point of the light source 7. Stated another way, the light beam is not focused on the mask 1. In this regard, Applicant refers to Fig. 1 of Suzki (i.e., parallel dashed lines or collimated beam). Applicant also refers to the description at col. 2, lines 47-48 of Suzki.

Accordingly, Applicant respectfully submits that key differences between the combination described in independent claim 1 of the instant application and the disclosure of Suzki is as follows. Independent claim 1 of the instant application describes a combination of features in which an information surface (for example, the optical disc 23) and the light source are in a conjugate relationship. In the arrangement disclosed in Suzki, the information surface (more particularly, the mask 1 or wafer 2) and the light source are not in a conjugate relationship.

More specifically, the mask 1 or wafer 2 in Suzki can be understood as being an information surface or an object area. Applicant respectfully submits that this information surface is not positioned at the conjugate point of the light source 7. Applicant respectfully submits that it is necessary in the optical system of Suzki that the light beam is not focused on the mask 1 but instead has a certain beam diameter on the mask 1 to obtain an object image by the image sensor 13.

On the contrary, according to the present invention, Applicant respectfully submits that the light beam is focused on the information surface (for example, the optical disc 23). See, for example, page 9, lines 12-13 of the specification of the instant application. In other words, the information surface (for example, the optical disc 23) and the light detector 28 are positioned at the conjugate point of the light source 7 in order to read information on the optical disc 23.

For at least the foregoing reasons, Applicant respectfully submits that the above-described distinct and advantageous features of the combination of features of independent claim 1 of the present invention are neither disclosed, nor even suggested, in the cited references.

Independent claim 7 has been amended to include similar features as discussed above with regard to newly-amended independent claim 1 of the instant application. Accordingly,

similar arguments as set forth above with regard to newly-amended independent claim 1 of the instant application also apply to newly-amended independent claim 7 of the instant application.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art of record, whether taken separately or combined, do not teach or suggest each feature of independent claims 1 and 7 of the instant application as newly-amended. As pointed out by MPEP § 2143.03, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.’ In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”

Furthermore, Applicant respectfully asserts that the dependent claims 2, 3, 5, 6 and 8, as well as newly-added dependent claim 9, are allowable at least because of their dependence from independent claims 1 or 7 and the reasons discussed previously.

### **CONCLUSION**

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response; the Examiner is invited to contact Applicants’ undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.


This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER BIDDLE & REATH LLP**

Dated: November 10, 2008

By:

A handwritten signature in black ink, appearing to read "Paul A. Fournier", written over a horizontal line.

Paul A. Fournier

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